



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/694,924

10/27/2003

Justin Monk

020375-043700US

5090

20350 7590 12/31/2008
TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

SHUMATE, PAUL W

ART UNIT

PAPER NUMBER

3693

MAIL DATE

DELIVERY MODE

12/31/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/694,924	Applicant(s) MONK, JUSTIN	
	Examiner PAUL SHUMATE	Art Unit 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 20-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 20-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. The examiner notes that the finality of the previous Office action was withdrawn in order to present Applicant with the most relevant prior art. Additional claim limitations added in Applicant's amendment filed 2/28/2008 necessitated the new grounds of rejection presented in this Office action.
2. Claims 1-9 and 20-25 are currently pending.
3. Claims 10-19 and 26-33 have been cancelled by Applicant without prejudice or disclaimer.
4. Claims 1, 6, 20, and 22 were amended in the communication filed 2/28/2008.
5. All pending claims have been examined and stand rejected.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim(s) 1-9 and 20-25 rejected under 35 U.S.C. 103(a) as being unpatentable over Teicher, US Patent No. 6,076,075, in view of Armetta et al. US Patent No. 5,864,830, in view of Hirka et al., US PGPub No.: 2003/0061157.

Claim 1:

Teicher discloses the following limitations:

- receiving credit-account parameters to be associated with the instrument; (see at least column 2 lines 43-49, column 9 lines 30-38, and column 10 lines 46-48)

Art Unit: 3693

- establishing a credit account associated with the instrument in accordance with the credit-account parameters; (see at least column 2 lines 43-49, column 9 lines 30-38, and column 10 lines 46-48)
- receiving stored-value-account parameters to be associated with the instrument; (see at least column 2 lines 50-52 and column 9 lines 30-38)
- establishing a stored-value account associated with the instrument in accordance with the stored-value-account parameters; (see at least column 2 lines 50-52 and column 9 lines 30-38)
- linking the credit account and the stored-value account; (see at least column 2 lines 53-54, column 9 lines 60-65, column 11 lines 8-12). The credit account and the stored-value account are linked since they are both included on a single electronic wallet. Further, the two accounts must be linked in one way or another in order for the electronic checkbook account to be able to load funds into the electronic purse stored-value account.

Teicher does not disclose the following limitation:

- issuing the chip card to the customer substantially contemporaneously with linking the credit account and the stored-value account.

Armetta, however, discloses “a method for configuring and linking one or more prepaid satellite spending cards to a cardholder’s host credit card [or card account] (see at least the abstract and column 1 lines 9-11)” in which he teaches more specifically “a method of configuring a satellite spending card linked to a host credit card and issued by an issuer (see at least column 6 lines 58-60).” It would have been obvious at the time the invention for one having ordinary skill in the art to combine the references stated above to create a method of linking a credit account and a stored-value account on a chip card at the time of issuance because this would enable the card user to immediately use the card with its intended functions.

Neither Teicher nor Armetta explicitly teach:

- wherein the instrument includes a single identifier such that a merchant is able to access funds from both the credit account and the stored-value account with the single identifier.

Art Unit: 3693

Hirka, however, teaches a multiple account advanced payment card which provides merchants and cardholders with access to multiple accounts, including credit card, bank, and stored-value accounts, using a single identifier (See at least paragraph 0008). It would have been obvious to a person having ordinary skill in the art at the time the invention was to incorporate the teachings of Hirka into the teachings of Teicher and Armetta and to include a single identifier for the electronic wallet which enables a merchant to access funds from both the credit account and the stored-value account with the single identifier because this allows cardholders to enjoy the benefits of multiple types of accounts while carrying only a single card and when the card enables a single account/identification number to access the multiple accounts associated with the card, the cardholder benefits from being able to use the card in a more flexible manner, transparent to the cardholder and the merchant, that also ensures the cardholder's accounts are put to best use (see at least paragraphs 0021, 0022, and 0029).

Claim 2:

Teicher discloses:

- initiating issuance of the instrument is performed after linking the credit account and the stored-value account.

This is a required step in providing a chip card with linked accounts and therefore does not further limit the claim. Teicher provides in at least column 2 lines 40-54 a smart card with an electronic purse linked to an electronic checkbook. It is inherent that Teicher's purse and checkbook be linked before issuing the electronic wallet card to the user, whether it be 1 year or 1 second before issuing the card, because if they were not linked when issued to a user, then the card being received would be a different product than the invention discloses.

Claim 3:

Teicher discloses:

- the credit-account parameters include specification of a credit limit. (see at least column 2 lines 43-54)

Teicher discloses in at least column 2 lines 43-54 an "electronic checkbook which bears information identifying at least one central account" as part of the "electronic wallet-smart card," and

Art Unit: 3693

explains that the “electronic checkbooks include conventional credit card and bank debit card accounts.” It is an inherent characteristic of all conventional credit card accounts to have either a preset spending limit, or, in the alternative, no preset spending limit. In either case, each specifies a credit limitation for said account.

Claim 4:

Teicher discloses:

- the stored-value-account parameters include specification of a limited set of one or more merchants at which the stored-value account may be used. (see at least column 16 lines 47-54)

Claim 5:

Regarding the following limitation:

- the stored-value-account parameters include specification of an initial value amount for the stored-value account.

This limitation is inherent in the process of creating and issuing any spending card which is associated with a stored-value account where stored-value information, such as the amount of available funds, is stored on the card itself. The card's stored-value amount must have an initial value amount of zero or a value greater than zero. If the stored-value amount was negative or undefined, the stored-value function of the card would be unusable as a stored-value spending card.

Claim 6:

Teicher discloses:

- receiving a request to reload value into the stored value account, the request being supported by funds from other than the credit account and augmenting a value amount for the stored-value account in accordance with the request. (see at least column 3 lines 11-14, column 7 lines 64-65, and column 22 lines 47-50)

Art Unit: 3693

Claim 7:

Teicher discloses:

- loading value equal to a specified fraction of an amount of a credit transaction executed with the instrument into the stored-value account in response to execution of the credit transaction. (see at least column 4 lines 9-12 and column 12 lines 33-37)

Claim 8:

Armetta discloses:

- generating a consolidated statement summarizing customer activity on the linked credit account and stored-value account (see at least column 3 lines 52-60)

Claim 9:

Armetta discloses:

- responding to a customer-service request relating to at least one of the linked credit account and stored-value account. (see at least column 6 lines 30-37)

Claims 20-25:

Claim 20 is parallel with the limitations in claim 1, thus is rejected on the same basis.

Claim 21 is parallel with the limitations in claim 2, thus is rejected on the same basis.

Claim 22 is parallel with the limitations in claim 6, thus is rejected on the same basis.

Claim 23 is parallel with the limitations in claim 7, thus is rejected on the same basis.

Claim 24 is parallel with the limitations in claim 8, thus is rejected on the same basis.

Claim 25 is parallel with the limitations in claim 9, thus is rejected on the same basis.

8. Claim(s) 1-4, 6-9, and 20-25 are **also** rejected under 35 U.S.C. 103(a) as being unpatentable over Todd, U.S. Publication No.: 2003/0061093, in view of Simpson, U.S. Patent No.: 6,070,153, further in view of Hirka et al., US PGPub No.: 2003/0061157..

Claim 1:

Todd teaches maintaining user, account, and reward information in a financial reward system (see at least paragraph(s) 0016-0018) where rewards that can be based on credit card, debit card, or

Art Unit: 3693

check transactions (see at least paragraph(s) 0061 and 0076) are recorded in a customer's reward record, which is an account of the specific customer's accumulated rewards amounts related to the account which funded the transaction (see at least paragraph(s) 0024 and 0028). Therefore Todd broadly teaches the following limitations:

- receiving credit-account parameters to be associated with the instrument; (see at least paragraph(s) 0016-0018 and 0032) In order to maintain user, account, and reward information, it would be inherent that the information would first have to be received.
- establishing a credit account associated with the instrument in accordance with the credit-account parameters; (see at least paragraph(s) 0016-0018, 0061, and 0076) In order to maintain user, account, and reward information or to conduct transactions funded by a financial account, it would be inherent that the account would have to first be established.
- receiving stored-value-account parameters to be associated with the instrument; (see at least paragraph(s) 0016-0018 and 0032) In order to maintain user, account, and reward information, it would be inherent that the information would first have to be received.
- establishing a stored-value account associated with the instrument in accordance with the stored-value-account parameters; (see at least paragraph(s) 0018 and 0028) In order to maintain reward record information or to accumulate value in a reward record it would be inherent that the reward record or reward account would have to first be established.
- linking the credit account and the stored-value account; (see at least paragraph(s) 0018 and 0032)
- and initiating issuance of the instrument to the customer substantially contemporaneously with linking the credit account and the stored-value account. (see at least paragraph(s) 0047, 0049, and 0061) In order for a customer to use a credit card, issued by a financial institution, to conduct financial transactions, it would be inherent that the credit card first be issued to the customer before such transactions could take place.

While Todd does broadly teach the limitations as shown above, Todd does not explicitly state that the linking of the credit and stored value accounts and initiating issuance of the instrument occur

Art Unit: 3693

substantially contemporaneously. Simpson, however, teaches that “applicants would complete application documentation for both accounts and return them to the Issuing Company [and then] separate account records would be set up for the credit card accounts and corresponding Investment Accounts. These data bases would be linked by account numbers and cross-referenced in that fashion (see at least column 6 lines 23-28).” Simpson also teaches that “simultaneously with the credit facility application the cardholder/investor fills out an IRA Application and Custodial Agreement (see at least column 3 line 66 to column 4 line 1).” It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the teachings of Todd and Simpson and to link the two accounts substantially contemporaneously with issuing the credit card to the user because these are the final steps in setting up the above stated system and it would increase efficiency to do these steps at about the same time.

Neither Todd nor Simpson explicitly teaches that the instrument includes a single identifier such that a merchant is able to access funds from both the credit account and the stored-value account with the single identifier. Hirka, however, teaches a multiple account advanced payment card which provides merchants and cardholders with access to multiple accounts, including credit card, bank, and stored-value accounts, using a single identifier (See at least paragraph 0008). It would have been obvious to a person having ordinary skill in the art at the time the invention was to incorporate the teachings of Hirka into the teachings of Teicher and to include a single identifier for the electronic wallet which enables a merchant to access funds from both the credit account and the stored-value account with the single identifier because this allows cardholders to enjoy the benefits of multiple types of accounts while carrying only a single card and when the card enables a single account/identification number to access the multiple accounts associated with the card, the cardholder benefits from being able to use the card in a more flexible manner, transparent to the cardholder and the merchant, that also ensures the cardholder's accounts are put to best use (see at least paragraphs 0021, 0022, and 0029).

Claim 2:

Simpson further teaches:

Art Unit: 3693

- initiating issuance of the instrument is performed after linking the credit account and the stored-value account. (see at least column 3 line 66 to column 4 line 1 and column 6 lines 23-28). Simpson teaches linking the two accounts during the application process. In order to issue the credit instrument to the customer, the application process would have to be completed and the application would have to have been approved. Therefore linking the two accounts happens before issuing the credit instrument to the customer.

Claim 3:

Simpson further teaches:

- the credit-account parameters include specification of a credit limit. (see at least column 4 lines 27-37)

Claim 4:

Todd further teaches:

- the stored-value-account parameters include specification of a limited set of one or more merchants at which the stored-value account may be used. (see at least paragraph(s) 0003)
Todd teaches that it is old and well known to offer rewards points that can be redeemable for products or services. As an example, Todd discloses the use of offering frequent flier mile reward points. The use of frequent flier miles are limited at least to airlines or businesses that sell airline tickets, therefore Todd teaches specifying a limited set of merchants at which the stored-value account may be used.

Claim 6:

Todd further teaches:

- receiving a request to reload value into the stored value account, the request being supported by funds from other than the credit account; (see at least paragraph(s) 0032, 0062, and 0082 in Todd)
- and augmenting a value amount for the stored-value account in accordance with the request. (see at least paragraph(s) 0032, 0062, and 0082)

Art Unit: 3693

Claim 7:

Todd further teaches:

- loading value equal to a specified fraction of an amount of a credit transaction executed with the instrument into the stored-value account in response to execution of the credit transaction. (see at least paragraph(s) 0007, 0024, 0027, 0073, and 0082)

Claim 8:

Todd further teaches:

- generating a consolidated statement summarizing customer activity on the linked credit account and stored-value account. (see at least paragraph(s) 0046 and 0081)

Claim 9:

Todd further teaches:

- responding to a customer-service request relating to at least one of the linked credit account and stored-value account. (see at least paragraph(s) 0067-0068)

Claims 20-25:

Claim 20 is parallel with the limitations in claim 1, thus is rejected on the same basis.

Claim 21 is parallel with the limitations in claim 2, thus is rejected on the same basis.

Claim 22 is parallel with the limitations in claim 6, thus is rejected on the same basis.

Claim 23 is parallel with the limitations in claim 7, thus is rejected on the same basis.

Claim 24 is parallel with the limitations in claim 8, thus is rejected on the same basis.

Claim 25 is parallel with the limitations in claim 9, thus is rejected on the same basis.

9. Claim(s) 5 rejected under 35 U.S.C. 103(a) as being unpatentable over Todd, in view of Simpson, in view of Hirka et al., further in view of Centura (<http://web.archive.org/web/19980211083417/www.centura.com/cashcards/travelsmart.html>).

Claim 5:

Todd, Simpson, and Hirka teach the limitations disclosed above, but they do not teach:

Art Unit: 3693

- the stored-value-account parameters include specification of an initial value amount for the stored-value account.

Centura, however, teaches “the Centura TravelSmart Program awards one travel point for every dollar you spend with your card-points you can use on any airline! And your points add up fast. That's because we give you 1,000 points just for signing up.” It would have been obvious at the time the invention was made to a person having ordinary skill in the art to incorporate the teachings of Centura and to offer an initial value in the associated stored-value account because this would encourage people to accept that offer instead of another similar offer, from a competitor, that may not offer an initial value in the stored-value account.

Response to Arguments

10. Applicant's arguments with respect to claim 1-9 and 20-25 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Applicant's amendment filed 2/28/2008 necessitated the new grounds of rejection presented in this Office action. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

12. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 3693

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Shumate whose telephone number is 571-270-1830. The examiner can normally be reached on M-F 8:30 AM - 6:00 PM, EST alt Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Name: Paul W. Shumate
Title: Patent Examiner
Date: 12/22/2008
Signature: /Paul Shumate/
Examiner, Art Unit 3693

/James A. Kramer/
Supervisory Patent Examiner, Art Unit 3693